

REMARKS

Instant claims 1-7, and 10-18 stand pending in the instant Application. The instant claims 10-14 are withdrawn by the Examiner.

**Claim Rejections: 35 U.S.C. §112**

Claims 16 and 17 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The 35 U.S.C. §112 rejections were previously addressed (Response to Office Action of June 23, 2008). Since these rejections are not mentioned in the Response to Arguments, Applicants believe these rejections have been overcome.

**Claim Rejections: 35 U.S.C. §102(b)/103**

Claims 2-5, 7 and 17 stand rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Friel (U.S. 5,731,377), hereafter "Friel".

The rejection has cited case law to the effect that "even though the product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself". However, the instantly recited process begets a different polymer than a polymer made from the same monomer mixture by the process of Friel.

The rejection, to be proper, must provide evidence that the product produced in Friel is the same as the product produced by the current inventive process and has failed to do this. Applicants have already produced data showing that the products are not the same. In the Declaration of Ralph C. Even of December 21, 2007, applicants provided chromatograms comparing pairs of polymers: in each case, one polymer prepared via the inventive process of the instantly recited claims, the other polymer prepared using a comparative process. The chromatograms showed that for each pairing, the inventive process has a much more pronounced elution due to low molecular weight polymers. The chromatograms were presented to demonstrate that the products of the inventive process are different to those made in Friel. Such was acknowledged on the record by the Examiner following presentation of the chromatograms at a personal interview (August 15, 2007). The chromatograms were originally presented in color with the key also in

color. Applicants have included herewith a Declaration of Ralph C. Even, under Rule 132, dated March 3, 2009, which re-produces the chromatograms for purposes of clarification for the record.

Additionally, the Declaration provides further support, by way of scrub resistance data, that the products are not the same.

The §102(b) rejection is, therefore, clearly improper and should be withdrawn.

**Claim Rejections: 35 U.S.C. §103(a)**

In the alternative, claims 2-5, 7 and 17 stand rejected under 35 U.S.C. §103(a) as obvious over Friel.

Applicants' original specification shows evidence of unexpected results for the products of the product-by-process claims (see, for example Table 4.1 in Example 4 on page 20 of the specification), and thus, the product resulting from the inventive process is not obvious with respect to Friel. The rejection has suggested that Applicants have not shown criticality for the entire scope of the presently claimed process on the final product, and previous data submitted by Applicants has been found to not be reasonably commensurate in scope with the claimed invention.

Applicants now submit additional data supporting patentability of the instantly recited claims; please see the attached Declaration of Ralph C. Even of March 3, 2009. The data show that significantly improved scrub resistance may be obtained in the product of the inventive product-by-process of the instantly recited claims compared to the product from the product-by process of the cited art. The product resulting from the inventive process is clearly different and the superior scrub resistance is unexpected considering the two polymers in each polymer pair have the same composition of monomers. The criticality of the presently claimed process on the final product is well supported; compare, for example, the three pairs of polymers represented by polymers 1-6. For each pair, the product resulting from the inventive product-by-process of the instantly recited claims has superior scrub resistance compared to that resulting from the product-by process of the cited art. Moreover, Applicants have presented data that is reasonably commensurate in scope with the claimed invention. Case law holds that data may be reasonably commensurate in scope with the claimed invention if a skilled artisan "could ascertain a

trend in the exemplified data that would allow him to reasonably extend the probative value thereof." *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). The Declaration of Ralph C. Even of March 3, 2009 states "As one skilled in the art, I find that the original data, along with the data contained herein, demonstrates in a manner reasonably commensurate in scope with the claimed invention that the instantly recited invention makes a different product from that of Friel, which inventive product may unexpectedly possess significantly higher scrub resistance, and which product is not obvious in light of Friel. That is, the data presented is sufficient for one skilled in the art to establish a reasonable correlation between the showing and the entire scope of the claim."

Applicants have shown that the product resulting from the inventive product-by-process of the instantly recited claims is both novel and unobvious with respect to Friel. Friel neither teaches nor suggests how to obtain a product such as that obtained by the process of the instantly recited claims.

The §103(a) rejection of claims 2-5, 7 and 17 as obvious over Friel should be withdrawn.

#### **Claim Rejections: 35 U.S.C. §103(a)**

Claim 6 stands rejected under 35 U.S.C. §103(a) as obvious over Friel. Claims 1, 3-7, and 16 stand rejected under 35 U.S.C. §103(a) as obvious over Friel in view of Ishikawa (US 4,325,856, "Ishikawa"). Claim 15 stands rejected under 35 U.S.C. §103(a) as obvious over Friel in view of Ishikawa and further in view of Bricker (US 5,502,089, "Bricker"). Claim 18 stands rejected under 35 U.S.C. §103(a) as obvious over Friel in view of Bricker.

Applicants contend that if claim 2 is patentable in light of Friel, then claims 1, 3-7 and 16 are also patentable over Friel in view of Ishikawa. Moreover, Applicants contend that if independent claim 2 is both novel and inventive, then the dependent claims are also patentable.

**Reconsideration of Restriction Requirement:**

The original application included claims 1-9. The applicants had cancelled claims 8 and 9, and submitted new claims 10-14. Claims 10-14 were withdrawn from consideration by the Examiner as being directed to a process of making the composition of instant claims 1-7. However, a composition and the method of making the same are considered to be one and the same invention. See *In re Ochiai*, 71 F.3d 1565 (Fed. Cir. 1995). Applicants have insured that instant claim 10 includes all of the limitations of instant claim 2. Accordingly, Applicants hereby respectfully request the rejoinder of Group I, claims 1-7, and Group II, claims 10-14 upon an indication of the allowability of the instant composition claims. See MPEP 8.21.04, 1<sup>st</sup> two paragraphs.

**CONCLUSION**

Attached herewith, Applicants have submitted a Declaration of Ralph C. Even of March 3, 2009.

Based on the foregoing remarks and the aforementioned Declaration, the instant claims are believed to be in condition for allowance. Applicants' agent thanks the Examiner for the time taken to review this response and Declaration.

Respectfully submitted,

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